

### **REMARKS**

The Office Action dated July 15, 2008, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 are currently pending in the application, of which claims 1, 19, 45, 60, 65-66, and 70 are independent claims. Claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 are respectfully submitted for consideration.

Claims 1-2, 5, 8-9, 11-20, 23, 26-27, 29-34, 36, 45-46, 49, 52-53, 55-60, 65-66, and 70 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2006/0030304 of Sofer et al. ("Sofer") in view of U.S. Patent No. 6,871,065 of Yamaguchi ("Yamaguchi"). As previously noted in the Response filed April 9, 2008, Sofer itself is not proper prior art, although Sofer is related to a patent that has an earlier filing date (U.S. Patent No. 6,920,487).

Rather than rely on the related patent, the Office Action has disputed the issue of whether Sofer is prior art. There is no statutory authority for the Office Action's position that Sofer is prior art. The Office Action argued that "Sofer itself does qualify as prior art since Sofer is a continuation (Not "related" as alleged by the applicant) of U.S. Patent No. 6,920,487, which was filed earlier than the filing date of applicant." Applicants respectfully note that Sofer is related to the '487 patent as being a continuation (of some kind) of the application upon which the '487 patent issued. Thus, the relation between the application on which the '487 patent issued and the application for Sofer is that of parent to child. Even assuming this relation to be the relation of a simple continuation

(rather than a continuation-in-part), 35 U.S.C. 102(e) does not provide for relation back to the parent application of a continuation application. Accordingly, whether Sofer is related to the '487 patent as a continuation, a divisional, or a continuation-in-part of the application upon which the '487 patent was granted, 35 U.S.C. 102(e) does not provide for the citation of Sofer, as such.

Furthermore, however, although Applicants respectfully disagree that Sofer is prior art, Sofer (alone or in combination with Yamaguchi) fails to disclose or suggest all of the elements of the rejected claims, thus the issue of whether Sofer is prior art may be considered moot. In other words, even if Sofer were prior art (not admitted), the rejection would still respectfully be traversed on the basis that the combination of cited references fails to disclose or suggest all of the elements of any of the presently pending claims.

Claim 1, upon which claims 2-3 and 5-18 depend, is directed to a system including a first system entity configured to provide a multimedia messaging service to a user equipment connected to a network of a system. The system also includes a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service. The first system entity is configured to send a message to the second system entity. The message comprises roaming information about the user equipment. The second system entity is configured to use the roaming information when providing the value added service to the user equipment.

Claim 19, upon which claims 20-21, 23-34, 36, and 61-61 depend, is directed to a method including receiving a message comprising roaming information about a user

equipment from a network entity providing a multimedia messaging service. The method also includes providing a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Claim 45, upon which claims 46-47, 49-59, and 63-64 depend, is directed to an apparatus including a receiver configured to receive a message from a network entity providing a multimedia messaging service, wherein the message comprises roaming information about a user equipment. The apparatus is configured to provide a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Claim 60 is directed to a computer-readable storage medium including a computer program set, wherein the execution of the program set in a computer causes the computer to execute a process. The process includes receiving a message from a network entity providing a multimedia messaging service, wherein the message comprises roaming information about a user equipment. The process also includes providing a value added service to a user of the user equipment via the multimedia messaging service using the roaming information.

Claim 65 is directed to a system including a first system entity means for providing multimedia messaging service to a user equipment connected to a network of the system. The system also includes a second system entity means for providing a value added service to a user of the user equipment via the multimedia messaging service. The system further includes sending means for sending a message from the first system entity

means to the second system entity means, wherein the message comprises roaming information about user equipment. The second system entity means is configured to use the roaming information when providing the value added service to the user equipment.

Claim 66 is directed to a method including providing a multimedia messaging service to user equipment connected to a network of a system. The method also includes providing a value added service to a user of the user equipment via the multimedia messaging service. The method further includes sending a message from a first system entity to a second system entity, wherein the message comprises roaming information about the user equipment. The method additionally includes using the roaming information when providing the value added service to the user equipment.

Claim 70 is directed to an apparatus including receiving means for receiving a message from a network entity providing a multimedia messaging service, wherein the message comprises roaming information about a user equipment. The apparatus also includes providing means for providing a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Applicants respectfully submit that the combination of Sofer and Yamaguchi fails to disclose or suggest all of the elements of any of the presently pending claims.

Sofer generally relates to a system and methods for global access to services for mobile telephone subscribers. Sofer describes its system as including a “packet-switch” network and intelligent gateways coupled to the “packet-switch” network, that allegedly enable roaming subscribers to continue using their value added services using familiar

access, interface, and language. Sofer also asserts that Sofer's system enables mobile operators to deliver new services to roamers and subscribers.

Sofer fails to disclose or suggest, at least, "A system comprising: a first system entity configured to provide a multimedia messaging service to a user equipment connected to a network of a system," as recited in claim 1 (or the similar recitation of claim 65).

Sofer fails to teach any kind of multimedia messaging service or a system entity providing a multimedia messaging service. Sofer merely discusses a short message service (see paragraph [0067]). As is established in the understanding of one of ordinary skill in the art, the short message service (SMS) is a different service than a multimedia messaging service (MMS). The SMS allows transmission of short text messages between communication devices. However, the SMS is not able to transmit multimedia messages. In particular, the Abstract and Figure 1 of Sofer, specifically cited in the Office Action, fail to disclose or suggest any system entity providing a multimedia messaging service. Items 20 and 30 in the cited part of Sofer simply refer to home and visited public land mobile networks (HPLMN and VPLMN, respectively). There is simply no mention at all of any multimedia messaging service functionality being involved. Thus, Sofer fails to disclose or suggest, "A system comprising: a first system entity configured to provide a multimedia messaging service to a user equipment connected to a network of a system," as recited in claim 1 (or the similar recitation of claim 65).

Sofer also fails to disclose or suggest, “a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service,” as recited in claim 1 (or the similar recitation of claim 65).

Sofer further fails to show or suggest any kind of system entity providing a value added service via a multimedia messaging service since Sofer does not disclose any kind of multimedia messaging service or a system entity even capable of providing a multimedia messaging service. For example, Sofer fails to show or suggest in any way that the value added services platform 25 of Sofer would provide a value added service via a multimedia messaging service. Thus, VAS platform 25 of Sofer does not correspond to the second system entity as claimed.

Sofer additionally fails to disclose or suggest, “wherein the first system entity is configured to send a message to the second system entity, wherein the message comprises roaming information about the user equipment,” as recited in claim 1 (or the similar recitation of claim 65).

Since Sofer fails to disclose the first system entity (configured to provide a multimedia messaging service to user equipment connected to a network of a system) and the second system entity (configured to provide a value added service to a user of the user equipment via the multimedia messaging service), Sofer also necessarily fails to disclose that such first system entity is configured to send any message to such second system entity, or more specifically, a message comprising roaming information about the user equipment.

Moreover, considering that the VAS platform 25 seems to be the only entity in Sofer capable of providing a value added service, it should also be noted that Sofer further fails to teach that any message comprising roaming information about the user equipment would be sent to said VAS platform 25 by any other entity.

If it is believed that Sofer actually discloses the above-identified claim feature, it is respectfully requested that the next Office Action clearly identify where exactly in Sofer such a feature is disclosed, and which particular system entities in Sofer is/are being considered relevant. For example, paragraphs [0019] to [0021], [0067], [0068], and [0070] of Sofer (specifically cited in the Office Action) do not appear to have any feature that could correspond to a first system entity (configured to provide a multimedia messaging service to user equipment connected to a network of a system) configured to send a message to a second system entity (configured to provide a value added service to a user of the user equipment via the multimedia messaging service) such that the message includes roaming information about the user equipment.

Additionally, Sofer fails to disclose or suggest, “and wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment,” as recited in claim 1, or the similar recitations of claim 65, which has its own scope. Again, since Sofer fails to disclose the second system entity (configured to provide a value added service to a user of the user equipment via the multimedia messaging service), Sofer also necessarily fails to disclose that such a second

system entity is configured to use the roaming information when providing the value added service to the user equipment.

Yamaguchi discloses a mobile communication system, method and program. However, also Yamaguchi fails to disclose the feature “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment” for the following reasons:

Firstly, it should be noted that the pending claims define that the second system entity is configured to provide a value added service to a user of the user equipment via the multimedia messaging service. However, Yamaguchi is completely silent about any such system entity which is configured to provide a value added service to a user of the user equipment via the multimedia messaging service. In fact, Yamaguchi does not seem to even mention *e.g.* the multimedia messaging service. Therefore none of the system entities of Yamaguchi correspond to the claimed “second system entity” and, consequently, when properly considering all the limitations of the claim, Yamaguchi cannot disclose the feature “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment.”

The Examiner has in particular referred to column 8, lines 60-65, of Yamaguchi which reads:

Then, when roaming information as information necessary to keep already provided content services is obtained from the GW unit which responds, it is kept to provide content services from the content server 24 that is an access request



destination via the second GW unit 23<sub>2</sub> using the roaming information.

In other words, the cited portion of Yamaguchi relates to a situation in which a mobile user terminal is connected to a GW (GateWay) unit via a mobile communication network which is a cellular telephone network. The GW unit is connected to the Internet, thereby providing a connection to the mobile terminal to the Internet. In this arrangement, all communication from the Internet to the mobile terminal and from the mobile terminal to the Internet goes thru the GW. For example, the GW unit executes the protocol conversion and the like and transmits the designated content data via the mobile communication network to the mobile user terminal.

Assuming, for the sake of discussion, that the mobile user terminal in Yamaguchi issues an access request to a content server in a first area in the mobile communication network, the following would occur. When the mobile user terminal moves from the first area to a second area, the mobile user terminal would be now connected to a radio communication base station which manages the second area in the mobile communication network. This is achieved by the execution of the roaming service. Roaming information as communication information necessary for communication with the content server is transferred from the radio communication base station managing the first area to the radio communication base station managing the second area. Therefore, it is possible for the mobile user terminal to keep the communication connection with the content server via the GW unit by the execution of the roaming service.

As one would expect, the roaming information is transferred from one base station to another base station. In Yamaguchi, base stations provide necessary links for communication between a mobile terminal and the mobile communication network but they are not using the roaming information when providing a value-added service. The roaming information is necessary to keep the communication connection alive. In addition, Yamaguchi does not seem to show or suggest that e.g. the content server 24 would use the roaming information in any way.

As a result of the above, it is apparent (1) that Yamaguchi fails to disclose any system entity corresponding to the second system entity as claimed, and (2) that Yamaguchi fails to disclose the use of the roaming information when providing the value added service to the user equipment by such second system entity as claimed.

Thus, it is respectfully submitted that Yamaguchi is unable to remedy even the deficiencies of Sofer for which it was cited. Yamaguchi naturally also does not remedy the above-identified deficiencies of Sofer for which it was not cited in the Office Action. Thus, the combination of Sofer and Yamaguchi fails to disclose or suggest all of the elements of, for example, claim 1.

Additionally, one of ordinary skill in the art would not find teaching, motivation, suggestion, or any other reason to combine the disclosures of Sofer and Yamaguchi or to combine them in such a way as to arrive at the claimed invention. As to the motivation to combine the alleged teaching of Yamaguchi into the system of Sofer, the Office Action asserted that such motivation would be “to provide the mobile communication system

suitable to provide contents to the mobile communication terminal which moves in a wide area, and a mobile communication method and a mobile communication program used in the mobile communication system.”

However, there is no such teaching in Yamaguchi that the isolated feature of col. 8, lines 60-65, of Yamaguchi would themselves provide the object of Yamaguchi's invention as described in col. 1, lines 10-15, and cited in the Office Action. In other words, the cited motivation would not lead one of ordinary skill in the art to extract the particular identified alleged teachings of Yamaguchi and incorporate those teachings into Sofer. Thus, the suggested motivation has no basis in the references (or in the knowledge of ordinary skill in the art) or any other reasoned ground, and thus the combination is improper and merely based on the impermissible form of hindsight reconstruction.

In addition, the system architectures of Sofer and Yamaguchi are different (see *e.g.* respective Figures 1 of both Sofer and Yamaguchi). Consequently, it is not clear how the suggested combination should or could be carried out. In other words, even if one of ordinary skill in the art were motivated to try to practice both Sofer and Yamaguchi (not admitted), it still would not be obvious to combine their teachings, because one of ordinary skill in the art would not have reasonable expectation of success in view of the different system architectures.

The features discussed above have been discussed with reference to independent claim 1. Each of independent claims 1, 19, 45, 60, 65-66 and 70 has its own scope, but each of claims 19, 45, 60, 65-66 and 70 recites at least similar features to those of claim 1

discussed above, and consequently is patentable over Sofer in view of Yamaguchi for at least the reasons already discussed above (for a more detailed explanation see pp. 23-26 of the Response filed May 8, 2008, which is hereby incorporated herein by reference). Accordingly, it is respectfully requested that the rejection of claims 1, 19, 45, 60, 65-66 and 70 be withdrawn.

Claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-34, 36, 46, 49, 52-53, and 55-59 depend respectively from, and further limit, claims 1, 19, and 45. Thus, each of claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-34, 36, 46, 49, 52-53, and 55-59 recites subject matter that is neither disclosed nor suggested in the combination of Sofer and Yamaguchi. Accordingly, it is respectfully requested that the rejection of claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-34, 36, 46, 49, 52-53, and 55-59 be withdrawn.

Although with respect to one aspect of the discussion of Sofer the Office Action modified the rejection, and although the Office Action in the "Response to Arguments" section disputed the "prior art" status of Sofer, the Office Action failed to address the numerous additional distinctions that exist between Sofer and the claimed invention and that were already identified in the Response filed May 8, 2008. 37 C.F.R. § 1.104(b) explicitly requires that "[t]he examiner's action will be complete as to all matters". "In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application" (MPEP § 707.07(f)). "Where the applicant traverses any rejection, the examiner should, if he or she repeats the

rejection, take note of the applicant's argument **and answer the substance of it** (*Id.*, emphasis added). Accordingly, it is respectfully submitted that any new Office Action that addresses these distinctions to make up for the omissions in the present Office Action, would have to be designated "non-final." Alternatively, if the omissions cannot be addressed, the appropriate course of action would simply be to issue a Notice of Allowance.

Claims 6-7, 24-25, 50-51, and 61-64 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer in view of Yamaguchi and further in view of U.S. Patent Application Publication No. 2003/0193967 of Fenton et al. ("Fenton"). Claims 3, 10, 21, 28, 47, and 54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sofer in view of Yamaguchi and further in view of U.S. Patent No. 6,917,813 of Elizondo ("Elizondo"). As noted above, Sofer is not proper prior art, and consequently both of these rejections are improper and should be withdrawn.

Additionally, for the Examiner's convenience it is noted that neither Fenton, Elizondo, nor a combination thereof could remedy the above-identified deficiencies of the combination of Sofer and Yamaguchi, even if Sofer were prior art (not admitted).

Fenton generally relates to a method, apparatus, and system for processing multimedia messages. As explained at paragraphs [0003] to [0007] thereof, Fenton aims to provide a method, apparatus, and system that process multimedia messages and is capable of supporting current and future multimedia messaging services, as well as to exploit the advances being made in the world multimedia community, with additional

mobile requirements. Accordingly, it is unsurprising that Fenton fails to remedy the above-identified deficiencies of the combination of Sofer and Yamaguchi.

Elizondo, as noted above, was also cited, but cannot remedy the deficiencies of Fenton and/or Sofer and/or Yamaguchi. Elizondo generally relates to provision of short message services. As explained at column 2, lines 47-56, thereof, Elizondo aims to provide a method that allows the HLR to determine the proper address for the MSC (or VLR) serving a roaming MS, when requested by an external node, while enabling communication between the external node and the MS, MSC, or VLR, so as to provide proper addressing of SMS services to MSs roaming in an SS7 network that is different from the MS home network, when SMS reception from SS7 networks is not being used by the MS. Accordingly, it is unsurprising that Elizondo fails to remedy the above-identified deficiencies of Sofer, Yamaguchi, and Fenton. Thus, it is respectfully requested that the rejections be withdrawn.


For the reasons set forth above, it is respectfully submitted that each of claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", is written over a horizontal line.

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